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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,276	12/21/1999	Jean-Baptiste Dumas Milne Edwards	GENSET.025CP1	7217

23557 7590 07/02/2003

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EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,276

Applicant(s)

EDWARDS ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-8,10-13,17,19-21 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) 1,4-8,10-13,17,19-21 and 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Applicant's amendment and request for reconsideration in Paper #18, filed on 4/21/03, is acknowledged and the amendments entered.

Currently, claims 1,4-8,10-13,17,19-21 and 25-34 are pending, but only claims 25-30 are under consideration. Claims 1,4-8,10-13,17,19-21 are withdrawn for reasons set forth in the previous Office action mailed 1/14/02, and claims 31-34 are withdrawn for being drawn to the invention of Group IV, a nonelected invention and a distinct invention from that of Group II as set forth in the Office action mailed 9/25/01.

Applicant's arguments in response to the previous Office Action, mailed 1/14/03, have been fully considered but they are not deemed to be persuasive. However, the rejections of claims 22-23 under 35 U.S.C. 101, 112, first paragraph, and the rejection of claim 22 under 35 U.S.C. 103 are hereby withdrawn in light of applicants' amendment in Paper #18, which canceled claims 22-23.

Claim Rejections-35 USC § 101/§ 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25-30 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific asserted utility or a well established utility.

Claims 25-30 are rejected for the same reasons as set forth for claims 22-23 in the previous Office actions mailed 1/14/02 and 1/14/03.

Applicants argue that the new claims are drawn to polypeptides having specific and substantial utility because they direct the extracellular secretion of a polypeptide. This is not found persuasive. The specification does not describe a polypeptide consisting of, or comprising, the amino acid sequence of -16 to -1 of SEQ ID NO:831, or a fragment thereof, and does not assert it being a secreted protein itself or directing other proteins being secreted. As a matter of fact, the specification asserts that the claimed polypeptides can be used to direct proteins to import into cells rather than export out. See page 162. Thus, one of ordinary skill in the art would have reasonable doubt on applicants' assertion and would perform further research to reasonably confirm that the polypeptide consisting of, or comprising, the amino acid sequence of -16 to -1 of SEQ ID NO:831 is indeed a secreted protein itself or directing other proteins being secreted out of a cell.

Neither the specification as filed nor any art of record discloses or suggests any property or activity for the claimed polypeptides such that another non-asserted utility would be well established for the polypeptides.

The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 25-30 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Claim Rejections-35 USC § 112

Claims 25-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As set forth above, the added new claims 25-30 are drawn to a polypeptide consisting of, or comprising, the amino acid sequence of -16 to -1 of SEQ ID NO:831, or a fragment thereof, and the polypeptide directs the extracellular secretion of a polypeptide to which said signal peptide is operably linked. However, the specification does not describe the sequence of -16 to -1 of SEQ ID NO:831 being a secreted protein itself or directing other proteins being secreted. The specification does not even describe the fragment of -16 to -1 of SEQ ID NO:831 at all. Thus, one skilled in the relevant art would have reasonable doubt that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "recombinant signal peptide" in claim 25 is vague and indefinite. It is unclear what constitutes the metes and bounds of a recombinant peptide. Is it a fusion peptide or does it have to be produced by a recombinant DNA? Claims 26-30 are rejected due to their dependency from claim 25 and thus also containing the limitation.

Conclusion

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

Art Unit: 1631

in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:
Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

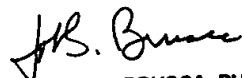
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D.



Patent Examiner


JOHN S. BRUSCA, PH.D
PRIMARY EXAMINER